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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,309

04/07/2004

Tapan Chandra

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23413 7590 08/21/2008
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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,309	Applicant(s) CHANDRA ET AL.	
	Examiner VICKEY RONESI	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-14,16,17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-14,16,17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/2008 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Objections

2. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, an adhesion promoter than is an ionomer it outside the scope of independent claim 1 given that the adhesion promoter of claim 1 is "selected from the group consisting of alpha-beta unsaturated carboxylic acid copolymers, polymers with pendant epoxy groups and combinations of two or more of the foregoing" and is therefore closed off from including other adhesion promoters such as ionomers.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, 7-12, 14, 16, 17, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1 and 14, the amount of adhesion promoter to 0.5-1.5 weight percent. It is the examiner's position that this amount fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the upper endpoint 1.5 weight percent in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for 1.5 weight percent of Primactor 5990I in Example 7 (Table) on 88 of the specification, there is no support for the amount of 1.5 weight percent for all adhesion promoters. Case law holds that, with respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

With respect to claims 3-5, 7-12, 16, 17, and 19, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

4. Claims 1, 3, 4, 7-14, 16, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '324 (DE 3917324, machine translation) in view of Silvi et al (US 5,843,340).

Pending a full English-language translation of DE 3 '324, in setting forth this rejection, a machine translation has been relied upon.

DE '324 discloses a thermoplastic composition for use in automobile parts (page 7) comprising 5-95.5 wt % polyamide such as nylon-6,9 (page 1); 4-70 wt % polyphenylene ether, 0.5-25 wt % copolymer of acrylic acid (page 1), 0-25 wt % impact modifier such as those prepared from styrene (page 3); and additives including oxidation inhibitors (i.e., antioxidants) such as sterically hindered phenols and metals salts such as sodium halides (page 7).

DE '324 teaches the use of inorganic fillers (pages 1 and 6) and the use of its composition in automotive molded articles, however, it fails to disclose the use of electrically conductive filler such as conductive carbon black.

Silvi et al discloses a conductive polyphenylene ether/polyamide composition and teaches that these blends are widely used in automotive molded articles because it is common to use electrostatic powder coating for its convenience and environmental advantages, wherein electrostatic powder coating requires a relatively high surface electrical conductivity (col. 1, lines 6-30). Usually, the amount of carbon black is the amount necessary to afford a composition of the desired conductivity and is in the range of about 1-5.0 parts by weight per 100 parts by resin 9col. 5, 1 lines 1-8).

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Given that the molded articles of DE '324 are used in automotive parts and further given that Silvi et al teaches that automotive parts are desirably coated by electrostatic coating, it would have been obvious to one of ordinary skill in the art to utilize a conductive filler in the composition of Nishio et al in order for it to be coated by electrostatic coating.

5. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '324 (DE 3917324, machine translation) in view of Silvi et al (US 5,843,340) and further in view of Bastiaens et al (US 6,353,050).

The discussion with respect to DE '324 and Silvi et al in paragraph 4 above is incorporated here by reference.

DE '324 fails to disclose the use of a polyester ionomer, however, note page 7 where DE '324 teaches the use of conventional additives.

Bastiaens et al discloses a thermoplastic composition comprising compatibilized polyarylene ether/polyamide and teaches that adding polyester ionomer results in a composition having reduced moisture absorption and improved paint adhesion (abstract).

Given that DE '324 is open to the use of conventional additives and further given the advantages had by using a polyester ionomer as taught by Bastiaens et al, it would have been obvious to one of ordinary skill in the art to utilize a polyester ionomer as an adhesion promoter in the composition of Nishio et al.

6. Claims 1, 3, 4, 6, 8, 11, 12, 14, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio et al (US 5,112,907) in view of Silvi et al (US 5,843,340).

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The rejection is adequately set forth in paragraph 6 of Office action mailed on 7/12/2007 and is incorporated here by reference.

7. Claims 5, 9, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio et al (US 5,112,907) in view of Silvi et al (US 5,843,340) and further in view of Bastiaens et al (US 6,353,050).

The rejection is adequately set forth in paragraph 7 of Office action mailed on 7/12/2007 and is incorporated here by reference.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Three (3) double patenting rejections are set forth below:

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Double Patenting, I

8. Claims 1, 3, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of copending Application No.

11/278724 (published as US 2007/0238832). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '724 claims a method of making a thermoplastic composition, wherein the composition comprises poly(arylene ether), polyamide, a compatibilizer, electrically conductive carbon, 1-5 wt % of a first impact modifier which reads on the presently claimed adhesion promoter and a second impact modifier which reads on the presently claimed impact modifier. While the claims of US appl. '724 are drawn to a method, it still would have been obvious to one of ordinary skill in the art to obtain the presently claimed composition given that the presently claimed composition is disclosed in its method steps.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1, 3, and 14 are directed to an invention not patentably distinct from claim 5 of commonly assigned copending Application No. 11/278724 (published as US 2007/0238832). Specifically, see the discussion set forth in paragraph 8 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/278724 (published as US 2007/0238832), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a)

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if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Double Patenting, II

10. Claims 1, 3, 11, 12, 14, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 11/278,727 (published as US 2007/0235698). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '727 claims a vehicular body part comprising a compatibilized blend of 15-65 wt % poly(arylene ether) and 30-85 wt % polyamide, electrically conductive carbon black, 1-5 wt % of a first impact modifier which reads on the presently claimed adhesion promoter, and 1-15 wt % of a second impact modifier which reads on the presently claimed impact modifier. While the claims of US appl. '727 are drawn to a vehicular body part article, it still would have

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been obvious to one of ordinary skill in the art to obtain the presently claimed composition given that the presently claimed composition is disclosed in the vehicular body part articlew.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1, 3, 11, 12, 14, and 19 are directed to an invention not patentably distinct from claim 8 of commonly assigned copending Application No. 11/278,727 (published as US 2007/0235698). Specifically, see the discussion set forth in paragraph 10 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/278,727 (published as US 2007/0235698), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

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Double Patenting, III

12. Claims 1, 3, 11, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 11/278,720 (published as US 2007/0235697). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '720 claims a composition comprising a compatibilized blend of 15-65 wt % poly(arylene ether) and 30-85 wt % polyamide, 0.1-5.0 wt % electrically conductive carbon black, 1-5 wt % of a first impact modifier which reads on the presently claimed adhesion promoter, and 1-15 wt % of a second impact modifier which reads on the presently claimed impact modifier.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1, 3, 11, and 14 are directed to an invention not patentably distinct from claim 14 of commonly assigned copending Application No. 11/278,720 (published as US 2007/0235697). Specifically, see the discussion set forth in paragraph 13 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/278,720 (published as US 2007/0235697), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the

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conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

14. Applicant's arguments filed 7/21/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that applicant has support for 1.5 wt % adhesion promoter; (B) that criticality has been established for adhesion promoter in amounts of less than 2.5 wt %; and (C) that Nishio et al does not teach the styrene-based impact modifiers like presently claimed.

With respect to argument (A), applicant cites other examples which have a blend of adhesion promoters in an amount of 1.5 wt %, however, this is insufficient to establish support given that this amount of 1.5 wt % includes ionomer adhesion promoter which is outside the scope of the adhesion promoter of claims 1 and 14 given the closed claim language "selected from the group consisting of". The examiner maintains that the one example that includes Primactor 5990I can support broad claim language regarding the amount of adhesion promoter.

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With respect to argument (B), the data is not reasonably commensurate in scope with the scope with claims which is to an adhesion promoter selected from alpha-beta unsaturated carboxylic acid copolymer polymers with pendant epoxy groups, or mixtures thereof given that the exemplified adhesion promoters only include Vancryl 68 (styrene-acrylic acid copolymer), Primacor 5990I (ethylene-acrylic acid copolymer), and ECN (epoxy-cresol-novolac). Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Furthermore, case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

With respect to argument (C), the examiner agrees. Those rejections with the styrene-containing impact modifier over Nishio et al have been withdrawn.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/14/2008

vr

/Vickey Ronesi/
Examiner, Art Unit 1796